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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,596	07/31/2000	Michael J. Adang	UGR-100X	4280

23557 7590 01/28/2003

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

*Restriction Purposes Only*

Application No.  
09/629,596

Applicant(s)  
Adang et al

Examiner  
Padmashri Ponnaluri

Art Unit  
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☒ Other: *Restriction fax cover sheet*

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### **DETAILED ACTION**

1. Claims 1-19 are currently pending in this application.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Andrew Wang, Supervisory Patent Examiner at [andrew.wang@uspto.gov](mailto:andrew.wang@uspto.gov) or 7(703)306-3217. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a polynucleotide molecule that comprises a nucleotide sequence encoding an active toxin and a nucleotide sequence encoding a phage protein, classified in class 536, subclass 23.4.
  - II. Claims 6-8, drawn to a polypeptide molecule comprising a phage region and a toxin region, classified in class 536, subclass 69.7.

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- III. Claims 9-14, drawn to a method of preparing active *Bacillus thuringiensis* toxins, classified in class 435, subclass 69.7.

Note that claim 13 is dependent on claim 13, which is considered as dependent on claim 12 and grouped along with claim 12.

- IV. Claims 15-16, drawn to a method of screening for novel Bt toxins, classified in class 435, subclass 5.
- V. Claim 17, drawn to a phage clone comprising phage that comprises a polynucleotide molecule having a nucleotide sequence that encodes a toxin, classified in class 435, subclass 320.1.
- VI. Claim 18, drawn to an isolated polynucleotide molecule produced by the method of claim 16, classified in class 536, subclass 23.4.
- VII. Claim 19, drawn to one or more plant cells transformed with a polynucleotide molecule produced by the method of claim 16, classified in class 435, subclass 410.

3. The inventions are distinct, each from the other because of the following reasons: a)

Inventions of groups I, II, V-VII are all drawn to patentably distinct products. The different products of groups I-II and V-VII are not capable of use together and have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Thus restriction between the groups is proper.

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b) Inventions of groups III and IV are related as process of making a product (Bt toxins) and process of screening for the product. The two different methods are distinct from each other and have different modes of operation and different results. Thus restriction between the groups is proper.

c) Inventions of group I and groups III, IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of group I can be used in several different process other than in groups III and IV methods (i.e., in therapeutics (gene transfer)).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Even though some of the groups are classified in the same class/subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive. Therefore, these do not create an undue search burden, and restriction for examination purposes as indicated is proper.

5. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising:

a) a single species of toxin;

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- b) a single SEQ ID NO of a fusion protein sequence from Figure 1;
- c) prokaryotic cell.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

8. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri  
Patent Examiner  
Technology Center 1600  
Art Unit 1639  
23 January 2003

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

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PHONE NUMBER:

TO EXAMINER: P. Ponnaluri

ART UNIT: 1639

SERIAL NUMBER: 09/629,596

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
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\_\_\_\_\_

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